REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action dated June 4, 2004 are respectfully requested. A separate petition for a one-month extension of time accompanies this amendment.

I. Amendments

Claims 3, 11, 23, and 34 have been amended to clarify a term. In claims 3, 11, 23, and 34, "when the current connection has the same priority as the new connection, using" has been replaced by "said unique identifier is" to clarify a new term.

II. Rejections under 35 U.S.C. § 112, second paragraph

Claim 1 has been amended to specify the subject matter which the applicant regards as the invention and to render the claim definite. In particular, lines 6-7 of claim 1 have been amended to state, "allowing a priority determination to be made; and when the current connection has a higher priority than the conflicting connection, keeping the current connection". The applicant requests reconsideration of claim 1 in light of this amendment.

III. Rejections under 35 U.S.C. § 102

A. The Applied Art

U.S. Patent No. 5,680,402 to Olnowich et al. (*Olnowich*) is directed to a dual priority switching apparatus for making input port to output port connections on a requested basis quickly and dynamically.

B. Analysis

Distinctions between claims 1 and 9 and *Olnowich* will first be discussed, followed by distinctions between *Olnowich* and the remaining dependent claims.

As noted above, *Olnowich* discloses a method for contacting a computer network. *Olnowich* fails to disclose a method for determining higher priority when a current connection has the same priority as a conflicting connection. In particular, *Olnowich* fails to disclose a method in which "when the current connection has the same priority as the conflicting connection, using a unique identifier as a tiebreaker to determine which connection has a higher priority". Instead, *Olnowich* discloses a

method for determining higher priority between the current connection and the conflicting connection only when the priorities of the two connections differ. Column 23, lines 56-67. Claim 1 and claim 9 have been amended to clarify the language of previously pending claim 1 and claim 9. In other words, claim 1 and claim 9 have been amended to recite, among other limitations, a method in which "when the current connection has the same priority as the conflicting connection, using a unique identifier as a tiebreaker to determine which connection has a higher priority". *Olnowich* fails to disclose such a method for determining higher priority between a current connection and a conflicting connection having the same priority. For at least this reason, claim 1 and claim 9 are patentable over *Olnowich.*

In addition, *Olnowich* fails to disclose a method in which "a switch that a conflicting connection contacts to request a connection is responsible for detecting a conflict". Instead, *Olnowich* discloses detection of a conflict by a switch other than the one that a conflicting connection contacts to request a connection. Column 21, lines 42-53. In particular, *Olnowich* discloses that the conflicting connection contacts a stage 2 switch to request connection. Figure 11. The stage 2 switch "cannot detect that deadlock has occurred". Column 21, lines 46-47. According to *Olnowich*, "The problem must therefore be detected by the stage 1 switch, which can detect that the multi-cast operation is not progressing the way it should be in the following stage". Column 21, lines 47-50. Figure 11 reveals that switch 1, which detects that deadlock has occurred, is not the switch that the conflicting connection contacts to request a connection. Claim 9 has been amended to clarify the language of previously pending claim 9. In other words, claim 9 has been amended to recite, among other limitations, a method in which "a switch that a conflicting connection contacts to request a connection is responsible for detecting a conflict". *Olnowich* fails to disclose such a method for detecting a conflict. For at least this reason, the applicant believes that claim 9 is patentable over *Olnowich.*

As is known, to anticipate a claim under 35 U.S.C. § 102, the reference must teach every element of the claim.[1] *Olnowich* fails to disclose every limitation recited in claim 1 and claim 9. Since claim 1 and claim 9 are allowable, based on at least the above reasons, the claims that depend on claim 1 and claim 9 are likewise allowable. Thus, for at least this reason, claims 3, 4, 11, and 12, in addition to claim 1 and claim 9, are patentable over *Olnowich*.

IV.   Rejections under 35 U.S.C. § 103

A.   The Applied Art

U.S. Patent No. 5,680,402 to Olnowich et al. (*Olnowich*) is directed to a dual priority switching apparatus for making input port to output port connections on a requested basis quickly and dynamically.

U.S. Patent No. 5,892,923 to Yasuda et al. (*Yasuda*) is directed to a parallel computer using a simply structured network which allows loads on message-transferring routes to be as equally distributed as possible and which eases possible conflict between different types of messages being transferred.

B.   Analysis

The Applied References Even if Combined, Fail to Disclose or Suggest the Claimed Invention.

As noted above, *Olnowich* discloses a dual priority switching apparatus for making input port to output port connections, and *Yasuda* discloses a parallel computer using a simply structured network which allows loads on message-transferring routes to be as equally distributed as possible. Both *Olnowich* and *Yasuda* fail to disclose a method in which "a switch that a conflicting connection contacts to request a connection is responsible for detecting a conflict". Instead, *Olnowich* discloses detection of a

---

[1] MPEP section 2131, p. 70 (Feb. 2003, Rev. 1). *See also, Ex parte Levy,* 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990) (to establish a *prima facie* case of anticipation, the Examiner must identify where "each and every facet of the claimed invention is disclosed in the applied reference."); *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.,* 45 F.3d 1550, 1554 (Fed. Cir. 1995) (anticipation requires that each claim element must be identical to a corresponding element in the applied reference); *Atlas Powder Co. v. E.I. duPont*

conflict by a switch other than the one that a conflicting connection contacts to request a connection. Column 21, lines 42-53. In particular, *Olnowich* discloses that the conflicting connection contacts a stage 2 switch to request connection. Figure 11. The stage 2 switch "cannot detect that deadlock has occurred". Column 21, lines 46-47. According to *Olnowich*, "The problem must therefore be detected by the stage 1 switch, which can detect that the multi-cast operation is not progressing the way it should be in the following stage". Column 21, lines 47-50. Figure 11 reveals that switch 1, which detects that deadlock has occurred, is not the switch that the conflicting connection contacts to request a connection. *Yasuda* simply fails to mention any relationship between a switch and the detection of a conflict. Claim 32 has been amended to clarify the language of previously pending claim 32. In other words, claim 32 has been amended to recite, among other limitations, a method in which "a switch that a conflicting connection contacts to request a connection is responsible for detecting a conflict". Both *Olnowich* and *Yasuda* fail to disclose such a method for detecting a conflict. As explained below, *Olnowich* and *Yasuda* would not be combined. However, even if they were combined, neither *Olnowich* nor *Yasuda* teach or suggest a method in which "a switch that a conflicting connection contacts to request a connection is responsible for detecting a conflict". For at least this reason, the applicant believes that claim 32 is patentable over the combination of *Olnowich* and *Yasuda*.

In addition, both *Olnowich* and *Yasuda* fail to disclose a method for determining higher priority when a current connection has the same priority as a conflicting connection. In particular, both *Olnowich* and *Yasuda* fail to disclose a method in which "when the current connection has the same priority as the conflicting connection, using a unique identifier as a tiebreaker to determine which connection has a higher priority". Instead, both *Olnowich* and *Yasuda* disclose a method for determining higher priority between the current connection and the conflicting connection only when the priorities of the two connections differ. Column 23, lines 56-67 and Column 4, lines 8-17. Claim 20 and claim 32 have been amended to clarify the language of previously pending claim 20 and claim 32. In other words, claim 20 and claim 32 have been amended to recite,

---

De Nemours, 750 F.2d 1569, 1574 (1984) (the failure to mention "a claimed element (in) a prior art reference is enough to negate anticipation by that reference").

among other limitations, a method in which "when the current connection has the same priority as the conflicting connection, using a unique identifier as a tiebreaker to determine which connection has a higher priority". Both *Olnowich* and *Yasuda* fail to disclose such a method for determining higher priority between two connections with the same priority. As explained below, *Olnowich* and *Yasuda* would not be combined. However, even if they were combined, neither *Olnowich* nor *Yasuda* teach or suggest a method in which "when the current connection has the same priority as the conflicting connection, using a unique identifier as a tiebreaker to determine which connection has a higher priority". For at least this reason, the applicant believes that claim 20 and claim 32 are patentable over the combination of *Olnowich* and *Yasuda*.

Since claim 20 and claim 32 are allowable, based on at least the above reasons, the claims that depend on claim 20 and claim 32 are likewise allowable. Thus, for at least this reason, claims 23, 24, 29, 34, and 35, in addition to claim 20 and claim 32, are patentable over the combination of *Olnowich* and *Yasuda*.

With respect to claims 2 and 10, as noted above, claim 1 and claim 9 have been amended to disclose a method in which "when the current connection has the same priority as the conflicting connection, using a unique identifier as a tiebreaker to determine which connection has a higher priority". As noted above, both *Olnowich* and *Yasuda* fail to disclose such a method for determining higher priority when an existing connection has the same priority as a conflicting connection. For at least this reason, claims 1 and 9 are patentable over the combination of *Olnowich* and *Yasuda*. Since claim 1 and claim 9 are allowable, based on at least the above reasons, the claims that depend on claim 1 and claim 9 are likewise allowable. Thus, for at least this reason, claims 2 and 10, in addition to claim 1 and claim 9 , are patentable over the combination of *Olnowich* and *Yasuda*.

<u>The Applied References Lack a Specific Suggestion to Combine Them As Argued in the Office Action</u>

Independent claims are allowable not only because they recite limitations not found in the references (even if combined), but for at least the following additional reasons. For example, there is no motivation to combine the various references as suggested in the Office Action. According to the Manual of Patent Examining

Procedure ("MPEP") and controlling case law, the motivation to combine references cannot be based on mere common knowledge and common sense as to benefits that would result from such a combination, but instead must be based on specific teachings in the prior art, such as a specific suggestion in a prior art reference. For example, last year the Federal Circuit rejected an argument by the PTO's Board of Patent Appeals and Interferences that the ability to combine the teachings of two prior art references to produce beneficial results was sufficient motivation to combine them, and thus overturned the Board's finding of obviousness because of the failure to provide a specific motivation in the prior art to combine the two references.[2] The MPEP provides similar instructions.[3]

Conversely, and in a manner similar to that rejected by the Federal Circuit, the present Office Action lacks any description of a motivation to combine the references. Thus, if the current rejection is maintained, the applicant's representative requests that the Examiner explain with the required specificity where a suggestion or motivation in the references for so combining the references may be found.[4]

As is known, one may not use the application as a blueprint to pick and choose teachings from various prior art references to construct the claimed invention ("impermissible hindsight reconstruction").[5] Assuming, for argument's sake, that it would be obvious to combine the teachings of *Olnowich* with *Yasuda*, then *Olnowich* would have done so because it would have provided at least some of the advantages of the presently claimed invention. *Olnowich's* failure to employ the teachings cited in *Yasuda* is persuasive proof that the combination recited in claim 20 and claim 32 are

---

[2] In re Sang-Su Lee, 277 F.3d 1338, 1341-1343 (Fed. Cir. 2002).

[3] Manual of Patent Examining Procedure, Section 2143 (noting that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure," citing in re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

[4] See, MPEP Section 2144.03.

[5] See, e.g., In re Gorman, 933 F.2d 982,987 (Fed. Cir. 1991), ("One cannot use hindsight construction to pick and choose between isolated disclosures in the prior art to deprecate the claimed invention.").

unobvious. For at least this reason, the applicant believes that claim 20 and claim 32 are patentable over the combination of *Olnowich* and *Yasuda*.
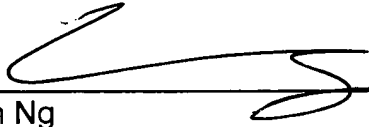
Since claim 20 and claim 32 are allowable, based on at least the above reasons, the claims that depend on claim 20 and claim 32 are likewise allowable. Thus, for at least this reason, claims 23, 24, 29, 34, and 35, in addition to claim 20 and claim 32, are patentable over the combination of *Olnowich* and *Yasuda*.

V.   Conclusion

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-8000.

Respectfully submitted,

Perkins Coie LLP

Date:_____

Chun Ng
Registration No. 36,878

Correspondence Address:
Customer No. 25096
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8000